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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,258	08/28/2001	Carlo Brugnara	C0875/7017/HCL/KA	7108

7590 12/03/2002

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Boston, MA 02210

EXAMINER

SACKEY, EBENEZER O

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/942,258

Applicant(s)
BRUGNARA ET AL.

Examiner
EBENEZER SACKEY

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1626



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 16, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other:

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DETAILED ACTION

Claims 1-15 are pending.

This is in response to applicants amendment B filed on 9/16/02.

Applicants have amended claims 1 and 6. Receipt of the information disclosure statement filed on 9/16/02 is acknowledged.

Response to Restriction

Applicant's election without traverse of Group IV in Paper No. 8 is acknowledged. In addition, applicants have elected compound number 75, Table A, page 31 of the specification and rheumatoid arthritis as the compound and inflammatory disease of choice.

Oath/Declaration

It is noted that the spelling of inventor "Emile M. Belott Jr." was corrected in parent application 09/159,335 and as indicated in the filling receipt of paper number 4. However, the oath or declaration has the name incorrectly spelled. Clarification of is required.

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Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,331,564. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is considerable overlap between the claims of '564' and the instant claims. The instant claims are drawn to methods for inhibiting unwanted cellular proliferation associated with an inflammatory disease with compounds of formula (I) wherein n is 0, 1, 2, 3 or 4; X is absent, C₁-C₃ alkyl, C₁-C₃ alkenyl or C₁-C₃ alkynyl; Y is C, N, P, Si or Ge; R₁ is absent, halo, R, OR, SR, NR₂, ONR₂, NO₂, CN, C(O)R, C(S)R, C(O)OR, C(S)OR, C(O)SR, C(S)SR, C(O)NR₂, C(S)NR₂, C(O)NR(OR), C(S)NR(OR), C(O)NR(SR), C(S)NR(SR), CH(CN)₂, CH[C(S)R]₂, CH[C(O)OR]₂, CH[C(O)SR]₂, CH[C(S)SR]₂ or aryl; Ar₁ is aryl, substituted aryl, heteroaryl other than imidazole, nitromidazole and triazole, heteroarylium other than imidazolium, nitroimidazolium and

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triazolium, C₅-C₈ cycloalkyl or C₅-C₈ heterocycloalkyl; Ar₂ is aryl or substituted aryl; Ar₃ is aryl, substituted aryl, biaryl, or heteroaryl other than imidazole, nitroimidazole and triazole; each R, aryl and alkyl substituents are as defined in the claims. The reference, i.e., '564' discloses methods for inhibiting unwanted cellular proliferation associated with an inflammatory diseases with compounds of formula (I). The instant claims differs from '564' in that Ar₁ and Ar₃ definition is as defined above except where Ar₁ and Ar₃ are heteroaryl other than imidazole, nitromidazole and triazole, heteroarylium other than imidazolium, nitroimidazolium and triazolium, C₅-C₈ cycloalkyl or C₅-C₈ heterocycloalkyl. However, the proviso in claims 1 and 6 is nothing more than the extension of monopoly because the selection of "some" among "many" is prima facie obvious, *in re Lemin*, 141, USPQ 814 (1964). The instant method would have been obvious from the reference teaching in the absence of any unobvious or unexpected properties especially since one of ordinary skill in the would expect compounds closely related structurally would have the same or virtually the same properties.

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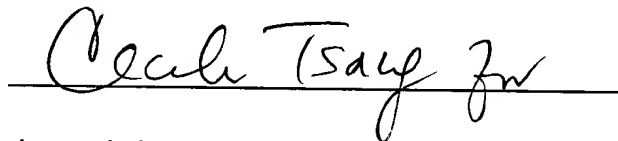
Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (703) 305-6889. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

EOS

December 2, 2002

A handwritten signature in cursive script, appearing to read "Cecile Tsay", is written over a horizontal line.

Joseph K. McKane

Supervisory Patent Examiner

Art Unit 1626, Group 1600

Technology Center 1